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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,348	11/19/2001	Parwinder Grewal	22727/04028	5799

24024 7590 07/27/2004

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EXAMINER

WARE, DEBORAH K

ART UNIT PAPER NUMBER

1651

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/993,348

Applicant(s)

GREWAL, PARWINDER

Examiner

Deborah K. Ware

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) 22-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-21 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/2/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-13 and 15-31 are presented for reconsideration on the merits.

#### ***Papers***

The amendment filed December 31, 2003 has been received and entered.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on January 2, 2004, was received and entered. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-13, 15-17 and 31 in the reply filed on May 5, 2004, is acknowledged. The traversal is on the ground(s) that there is no serious burden placed upon the examiner to examine all distinct and independent inventions set forth in the requirement. This is not found persuasive in its entirety because a method of preserving nematodes which requires a process step not required of the method for protecting plants is another step for which places a serious burden upon the examiner to search on the basis and evidenced by an additional search which would be required to be conducted in a separate classification. However, the argument that the method of protecting and composition therefore, have already been searched is found to be persuasive and the examiner has reconsidered the restriction requirement between these two groups, and hence the restriction between

Group I and II is removed but not the restriction of claims of Group III. Although a restriction between a method and product is proper when the two are classified differently and distinct from the other, the examiner has recombined the two groups per Applicants' request because the art of record appears to be relevant for both of these distinct inventions, and therefore, no serious burden is placed upon the examiner.

The requirement is still deemed proper for Group III and is therefore made FINAL.

Claims 22-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 5, 2004

#### ***Claim Objections***

Claims 7, 8, and 9 are objected to for "UV" wherein it is noted that Applicants made an amendment spelling out the meaning of it by replacing "UV" with —ultraviolet— in at least claim 20 but not in all of the claims wherein it occurs and it is suggested to use consistent terms in the claims.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-13, 15-17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al in view of Bedding et al and Popiel et al, all cited of

record, for those reasons set forth in the Office Action of September 29, 2003, see pages 2-4, all lines.

Applicant's arguments filed December 31, 2003, have been fully considered but they are not persuasive. The arguments that the Office has not met the three basic criteria for making a *prima facie* case of obviousness in this case are noted. However, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to Chang not disclosing the water activity, it should be noted that similar formulations have a water activity between 0.85 to 0.99, as disclosed by Bedding et al, which meets the claimed range. Further, similar formulations having a relative humidity (rh) at 70% and 25 ° C for 24 hours is disclosed to be preferable for nematodes in the teachings of Popiel et al, col. 8, lines 35 and 49-50. Thus, the combination of references meets the claimed water activity when exposed to air at 70% rh and 25 ° C for 24 hours. Indeed Chang et al teach the nematodes with carrier or solution as do the other cited references.

Further, Chang et al teach use of a water retentive compound for the nematodes, note the abstract. The water retentive characteristics of the polymer would be intrinsic to the compound and further Chang et al define these compounds to act as a water reservoir for the nematodes and hence to select for water activity as disclosed by Bedding when selecting and choosing a carrier as claimed for use with nematodes is

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clearly an obvious preference as disclosed by Popiel et al. The art combined herein clearly would have motivated one of skill in the art to select the formulation and carry out a method of protecting plants from insects. The art clearly teaches, or at least suggests, the claimed method. It should be further noted that Bedding et al teach that water activity should be preferably at 0.97 (note page 4, lines 17-18), which is well within the claimed range. Also the claimed method does not necessarily omit a container, per se, and thus, the argument that Bedding et al read in its entirety requires a container, but Applicants claimed method does not omit a container.

Also wherein Bedding is lacking any teachings of a rh of 70% at 25 ° C for 24 hours, as noted above Applicants are directed to the teachings of Popiel et al. Further wherein any teachings of Popiel et al is lacking such as the teaching of water activity, Bedding et al clearly remedy this deficiency as noted above. Popiel et al does teach that glycerol has been used but is not successful by itself hence Popiel et al do teach that sulfuric acid solutions are better but that glycerol has been used as a solution for controlling rh in air. Note col. 3, lines 45-68, and col. 4, lines 1-5. The substance of the claimed method is clearly taught or at least suggested by Chang et al and Bedding et al wherein water retentive polymers are disclosed. Also Bedding et al clearly do teach use of a substance or nematodes combined with a carrier medium (i.e. substance). Note the abstract. Therefore, Applicants' arguments that the substance is not disclosed by Chang et al and that they merely teach an entire system or container are not persuasive. Also the argument regarding Popiel et al not teaching the substance is not persuasive either, because they do teach a solution of which would be able to maintain

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the desired water activity by controlling rh. Note col. 3, lines 67-68. Thus, finally each of the claimed limitations are taught by the cited prior art for reasons noted above and those of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

All claims fail to be patentably distinguishable over the state of the art discussed above. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.


No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**DEBORAH K. WARE**  
**PATENT EXAMINER**

Deborah K. Ware  
July 24, 2004

  
DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 1651